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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,902	04/27/2001	Osman Kibar	259/221	9928
34263	7590	03/05/2004		
O'MELVENY & MEYERS 114 PACIFICA, SUITE 100 IRVINE, CA 92618			EXAMINER WEBER, JON P	
			ART UNIT 1651	PAPER NUMBER

DATE MAILED: 03/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,902

Applicant(s)

KIBAR, OSMAN

Examiner

Jon P Weber, Ph.D.

Art Unit

1651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17,20-53 and 80-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17,20-53 and 80-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/4/02, 5/27/03, 3/7/02, 11/21/03, 12/29/03
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Election/Restrictions

Applicant's election **without** traverse of Group I, now claims 1-17, 20-53 and 80-85 in the Paper filed 19 December 2003 is acknowledged. Non-elected claims have been canceled.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17, 20-53 and 80-85 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-17 of copending Application No. 09/993,326. Although the conflicting claims are not identical, they are not patentably distinct from each other because 09/993,326 requires the medium to have a different and intermediate dielectric constant with respect to the particles, whereas the instant claims do not require the dielectric constant of the medium to be different or intermediate between the dielectric constants of the particles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Examiner's Comments on the Prior Art

The closest art is MacDonald et al. (15 June 2001), which was published after the priority date of 27 April 2001, Sasaki et al. (EP 635994) and Nishimura et al. (EP 556748).

MacDonald et al. (2001) disclose separating particles having low refractive index from particles having high refractive index relative to the medium in a two-dimensional interferometric trap. MacDonald et al. are silent about the dielectric constant of the two particles or the medium or that the dielectric constant of the medium is intermediate between the two particles.

Sasaki et al. (EP 635994) disclose separating particles in a flow stream by a stripe pattern of radiation (scanning or interferometric) by means of differential braking forces on the particles based on 1) size, 2) refractive index, or 3) size and refractive index. Sasaki et al. (EP 635994) are silent about the dielectric constant of the two particles or the medium or that the dielectric constant of the medium is intermediate between the two particles.

Nishimura et al. (EP 556748) disclose separating particles in a medium by means of differential forces on the particles based on 1) size, 2) refractive index, or 3) size and refractive index. Nishimura et al. (EP 556748) are silent about the dielectric constant of the two particles or the medium or that the dielectric constant of the medium is intermediate between the two particles.

The concept of refractive index is close to but not the same as the concept of the dielectric constant. They are different and not clearly related properties.

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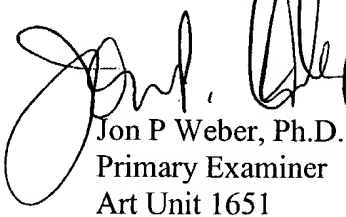
Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon P Weber, Ph.D. whose telephone number is 571-272-0925. The examiner can normally be reached on daily, off 1st Fri, 9/5/4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jon P Weber, Ph.D.
Primary Examiner
Art Unit 1651

JPW
1 March 2004